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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,717	07/29/2004	Homer E. Aguinaldo	PU2238	4716

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/710,717	Applicant(s) AGUINALDO ET AL.	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11 and 13-19 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-10, 14, 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Dewanjee et al. (USPN 6887164).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claim 1, Dewanjee et al. discloses an iron type club head comprising a body including a front wall having a ball-striking surface, and the body further including a rear surface having an external rear cavity formed therein wherein the rear surface includes an upper portion and a lower portion wherein the upper portion is separated from the lower portion by the external rear cavity and at least one groove and the lower portion of the rear surface having a notch formed therein wherein the notch is in communication with the external rear cavity (See Figures 3 and 4). Dewanjee et al. also shows a groove extending from the external cavity proximate an open end of the notch toward the toe and heel end of the club head body (See Figure 13). It is submitted that the front wall is integrally formed with the club head body being that they together produce one piece. Alternatively, Dewanjee et al. also notes that the club head body 22 and the face plate (front wall) may be made of stainless steel (See Column 3, lines 43 through 67, and Column 4, lines 19 through 33). Applicant does not note why it is essential to integrally form the front wall with the club head body. One having ordinary skill in the art would have seen such to be an obvious choice of product by process. The front wall and club head body of Dewanjee et al. would have performed equally as well because of the materials taught.

Regarding claim 2, Dewanjee et al. shows the at least one groove extending from the external rear cavity towards a heel end of the club head (See Figures 3 and 4).

Regarding claim 3, Dewanjee et al. shows the at least one groove including a first groove extending from the external rear cavity toward the heel end of the club head and a second groove extending toward a toe end of the club head (See Figure 3).

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Regarding claim 7, Dewanjee et al. shows an undercut recess along the external cavity for receiving a medallion (See Figures 1-4).

Regarding claim 8, Dewanjee et al. discloses the body made of steel (See Column 3 and 4).

Regarding claim 9, Dewanjee et al. discloses the moment of inertia  $I_{xx}$  through the center of gravity of 2450 to 3200 g-cm<sup>2</sup> and moment of inertia  $I_{zz}$  of 2200 to 3000 g-cm<sup>2</sup> (See Column 7, lines 4 through 16).

Regarding claim 10, see the above regarding claims 1, 3, and 8. Also Dewanjee et al. shows the first groove not being collinear with the second groove (See Figure 13).

Regarding claim 14, see the above regarding claim 7.

Regarding claim 15, see the above regarding claims 1, 3, 8, and 12.

Regarding claims 18 and 19, See the above regarding claims 1 and 10.

Claims 1-3, 6-10, <sup>11, 12</sup> 14, 15, and 18 and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Wieland et al. (USPN 6857973).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR

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1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claims 1, Wieland et al. discloses an iron type club head comprising a body including a front wall having a ball-striking surface, and the body further including a rear surface having an external rear cavity formed therein wherein the rear surface includes an upper portion and a lower portion wherein the upper portion is separated from the lower portion by the external rear cavity and at least one groove and the lower portion of the rear surface having a notch formed therein wherein the notch is in communication with the external rear cavity (See Figures 3 and 4). It is submitted that the front wall is integrally formed with the club head body being that they together produce one piece. Alternatively, Wieland et al. also notes that the club head body 22 and the face plate (front wall) may be made of stainless steel (See Column 3, lines 43 through 67, and Column 4, lines 19 through 33). Applicant does not note why it is essential to integrally form the front wall with the club head body. One having ordinary skill in the art would have seen such to be an obvious choice of product by process. The front wall and club head body of Wieland et al. would have performed equally as well because of the materials taught.

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Regarding claim 2, Wieland et al. shows the at least one groove extending from the external rear cavity towards a heel end of the club head (See Figures 3 and 4).

Regarding claim 3, Wieland et al. shows the at least one groove including a first groove extending from the external rear cavity toward the heel end of the club head and a second groove extending toward a toe end of the club head (See Figure 3).

Regarding claim 7, Wieland et al. shows an undercut recess along the external cavity for receiving a medallion (See Figures 1-4).

Regarding claim 8, Wieland et al. discloses the body made of steel (See Column 3).

Regarding claim 9, Wieland et al. discloses the moment of inertia  $I_{xx}$  through the center of gravity of 2450 to 3200 g-cm<sup>2</sup> and moment of inertia  $I_{zz}$  of 2200 to 3000 g-cm<sup>2</sup> (See Column 6, lines 26 through 38).

Regarding claim 10, see the above regarding claims 1, 3, and 8. Also Wieland et al. shows the first groove not being collinear with the second groove (See Figure 13).

Regarding claim 14, see the above regarding claim 7.

Regarding claim 15, see the above regarding claims 1, 3, and 8.

Regarding claims <sup>15,</sup> 16 and 17, Applicant does not disclose why the width of the groove and the length of the lower rearward surface are critical in attaining the invention. Wieland et al. discloses the first and second grooves having a width also. The width of the groove appears to add additional weight to the rear of the club head. The same result would appear to result from the length of the lower rearward surface. Thus on what the width appears to accomplish, one having ordinary skill in the art would

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have found the width of the grooves and the distance of the lower rearward surface from the upper rearward surface to be of any value so long as the weight of the club head is moved rearward.

✓  
and

Regarding claims 18 ~~and~~ 19, See the above regarding claims 1 and 10.

### ***Allowable Subject Matter***

Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 6-11, and 13-21 have been considered but are moot in view of the new ground(s) of rejection.

Amendments made to the claims merely places the rejection within the realm of 35 U.S.C. 103. For theses reasons, the above rejection has been furnished.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM  
SUPERVISORY PATENT EXAMINER